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HAROLD B. WILLEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1954

No. 773

TUBULAR SERVICE AND ENGINEERING COMPANY, TUBOSCOPE COMPANY, MYRON M. KINLEY, AND JOHN CARY KINLEY, *Petitioners*

v.

SUN OIL COMPANY, *Respondent*

BRIEF FOR RESPONDENT

In Opposition to Petition for a Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

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The Respondent submits that the Petition for a Writ of Certiorari in the above cause should be denied for the following reasons:

1. The Petition viewed as a whole does not provide any reasons of the character contemplated by Rule 38(5) for the issuance of the writ.

2. The questions presented by the Petition "involve the doctrine of file wrapper estoppel and the doctrine of equivalents. These doctrines are involved in practically all patent litigation." (Petition, p. 9.) These doctrines have been well settled by this Court. These questions have no uniqueness such

as to justify the attention of this Court in this particular private controversy.

3. The two legal questions presented appear from the Petition itself to include and require factual assumptions of the Petitioners that are diametrically opposed to the Findings of Fact made by the District Court and accepted and approved by the Court of Appeals for the Fifth Circuit (see Findings Nos. 36, 37, 38, 47, 48, 49; R. p. 1098-9, 1101). For this Court to consider these questions would require a third review of the evidence.

4. A file wrapper estoppel entails a change of position on the part of the patentee. In the case at bar, there was no such change of position because Chaney and Barnes were consistently claiming the same invention (Finding No. 48; R. p. 1101).

5. The doctrine of equivalents was not resorted to in this case either by the Plaintiff or the Courts below for the purpose of establishing infringement of the claims in suit. Instead, it was used merely to show that certain claims presented during the prosecution of the Chaney-Barnes application, both prior and subsequent to Petitioners' alleged adverse public uses, were directed to the same invention as the claims in suit and likewise would have covered the Petitioners' tubing calipers. The Courts below found that said alleged public uses "were not public uses" (Finding No. 47; R. p. 1101).

6. The Record contains no evidence whatever of the concentration of use of the invention in the Fifth Circuit that is alleged in the Petition; and the exact contrary is the fact, as is shown by the deposition of the Defendant-Petitioner M. M. Kinley taken

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herein on March 18, 1952, pages 57-8. That deposition is not included in the Record, and the foregoing portion is therefore given in a footnote.

Respectfully submitted,

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"Q. Do you and J. C. Kinley have any other companies than the Tubular Service and Engineering Company under licenses covering the McMahan Patent?

A. No, I don't think we do.

Q. Is the Technical Service Company of California licensed by you?

A. They handle our tool.

Q. They do not, then, operate under a license?

A. I don't think they have a license, a contract.

Q. Under what arrangements do they operate the tool?

A. They operate it on a fifty-fifty basis.

Q. Fifty-fifty of what?

A. Of the survey charge.

Q. That is their gross charge, then?

A. What?

Q. Their gross charge, then?

A. The charge to the customer for the survey."

Certificate of Service

A copy of this brief has been mailed to each of the attorneys for Petitioners, Earl Babcock, Esq. and Thomas O. Arnold, Esq., at their addresses of record, this 17th day of May, 1955.

Attorney for Respondent